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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/509,188 | 06/05/2000 | JAN DROUAUD | 065691/0184 | 8841 |

22428 7590 05/19/2004

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

BAUM, STUART F

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1638

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/509,188 | DROUAUD ET AL. | |
| | Examiner | Art Unit | |
| | Stuart F. Baum | 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-8,12 and 14-17 is/are allowed.
- 6) ☒ Claim(s) 9,10,13 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 2/12/2004 has been entered.
Claims 1, 3-10, and 12-18 are pending.
Claims 2, 11, and 19 have been canceled.
2. Claims 1, 3-10, and 12-18 are examined in the present office action.
3. Rejections and objections not set forth below are withdrawn.
4. The text of those sections of Title 35, U.S. Code not included in this office action can be found in a prior office action.

Scope of Enablement

5. Claims 9-10, 13 and 18 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a promoter sequence consisting essentially of nucleotides 1-2056 of SEQ ID NO:3 operably linked to a nucleic acid sequence encoding a protein capable of destroying a microspore, transformed into a plant from the Brassicaceae family, and a seed from said transformed plant comprising said DNA sequence consisting essentially of nucleotides 1-2056 of SEQ ID NO:3 operably linked to a nucleic acid sequence encoding a protein capable of destroying a microspore, does not reasonably provide enablement for claims drawn to said promoter operably linked to a nucleic acid encoding a subtilisin and wherein said promoter is induced comprising applying to the plant an insecticide molecule of the fluorophosphates family, or multiplying a plant that does not produce male gametes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. This rejection is

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maintained for the reasons of record set forth in the Official action mailed 11/14/2003.

Applicant's arguments filed 2/12/2004 have been fully considered but they are not persuasive.

Applicants' remarks do not specifically address the above rejected claims (page 5, 4th paragraph).

Written Description

6. Claims 10 and 18 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is maintained for the reasons of record set forth in the Official action mailed 11/14/2003. Applicant's arguments filed 2/12/2004 have been fully considered but they are not persuasive.

Applicants contend that there is no requirement that Applicants provide "specific structural features" of all the elements recited in the present claims (page 7, 2nd paragraph). Applicants contend that the specification discloses that a protease, such as a subtilisin, is a cytotoxic product.

The Office contends that Applicants have not disclosed any subtilisin proteins that function to destroy the microspores. Applicants also have not disclosed any nucleic acid sequences that encode a subtilisin that functions in Applicants' invention nor have Applicants described structural features of subtilisin proteins or of the nucleic acid sequence that encode subtilisins that are functional in Applicants' invention. Given the lack of disclosure of any

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subtilisin that functions in Applicants' invention, the written description requirement is not satisfied.

7. Claims 1, 3-8, 12, and 14-17 are allowable.
8. Claims 9-10, 13, and 18 remain rejected.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stuart F. Baum whose telephone number is **571-272-0792**. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read "Amy Nelson". The signature is fluid and cursive, with the first name "Amy" and last name "Nelson" clearly distinguishable.

Stuart F. Baum Ph.D.
Patent Examiner
Art Unit 1638
May 13, 2004

AMY J. NELSON, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600